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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002596
Party	Applicant Masayoshi Takayama
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TRADEMARK
Docket No. 110.2*2/T605

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MASAYOSHI TAKAYAMA, Applicant, v. D'AMICO HOLDING COMPANY, Registrant.	Concurrent Use No. 94002596 **APPLICANT'S OPPOSITION TO REGISTRANT'S CROSS MOTION FOR SUMMARY JUDGMENT** Mark: MASA Serial No.: 76/685,731 Filed: January 14, 2008

TAKAYAMA'S OPPOSITION TO D'AMICO'S CROSS MOTION FOR SUMMARY JUDGMENT

I. Introduction

In the present concurrent use proceeding, the only issue before the Board is whether or not Applicant Masayoshi Takayama ("Takayama") is entitled to the geographically restricted registration he seeks. In bringing its cross motion for summary judgment ("Cross-Motion,") D'Amico concedes that Takayama has satisfied the requirements of a concurrent use application. *See* Cross-Motion, pages 3-4. The sole matter in dispute is the scope of the geographic limitations in Takayama's application. Based on the unambiguous terms of the Coexistence and Settlement Agreement (the "Coexistence Agreement") to which D'Amico and Takayama are parties, Takayama maintains that he is entitled to a concurrent use registration covering "the United States with the exceptions of the state of Minnesota, the area within fifty miles of Minneapolis, Minnesota, and the state of Florida." *See* the Declaration of David Plumley submitted with Takayama's motion for summary judgment, Docket Entry No. 5, Exhibit A, a copy of the Coexistence Agreement. D'Amico asserts that Takayama is entitled to a more

geographically restricted concurrent use registration, limited to "New York, and 50 miles around New York City, NY." *See* Cross-Motion, page 1. As support for its position, D'Amico refers to the first recital of the Coexistence Agreement, but D'Amico ignores the specific terms and obligations of the Coexistence Agreement. As explained in Takayama's Motion for Summary Judgment which is now before the Board, when viewed in its entirety, the terms and obligations set forth in the Coexistence Agreement control the scope of Takayama's permitted use of the subject trademark without the need to resort to any parol evidence. However, even if the evidence submitted by D'Amico is considered, in view of the unambiguous language of the Coexistence Agreement, D'Amico's motion should be denied.

II. The Scope of D'Amico's Rights

In bringing its Cross-Motion, the only specific reference D'Amico makes to what it perceives as the permitted geographic scope of Takayama's concurrent use application is in the Introduction:

> [Takayama] is entitled to a concurrent use registration for the territory in which he actually used the MASA mark prior to D'Amico's constructive notice date of February 12, 2008, which is New York City, NY. However, because the parties agreed to a specific geographic territory for Plaintiff's use of the MASA mark, the Board may broaden Plaintiff's registrable rights to New York and 50 miles around New York City, NY.

Cross-Motion, page 1. Throughout the rest of its brief, D'Amico focuses on its rights, and appears to be seeking a ruling as to the geographic scope of its registrations, which currently have no geographic restrictions. Specifically, D'Amico makes the following arguments with respect to its geographic rights, with the final statement made in its concluding claim for relief:

- "There is no Genuine Dispute of Material Fact that D'Amico is Entitled to the Entire United States Except for New York and 50 Miles Around New York City, NY." See Cross-Motion, page 3.
- "D'Amico's registrable rights extend to the entire United States except for New York and 50 miles around New York City, NY." *Id.* page 4.

- "[T]here is no genuine dispute of material fact that D'Amico's registrable rights in its MASA & Design mark encompass the entire United States except for New York and 50 miles around New York City." *Id.* page 5.
- "D'Amico is entitled to the entire United States except for New York and 50 miles around New York City, NY." *Id.* page 6.
- "There is no genuine dispute of material fact that D'Amico is entitled to the entire United States except for New York and 50 miles around New York City, NY." *Id.* page 7, in concluding why D'Amico is entitled to summary judgment.

While D'Amico devotes much of its brief to arguments in support of its rights, Takayama has not challenged either of D'Amico's registrations in bringing this concurrent use proceeding. Rather, it is Takayama's position that according to the Coexistence Agreement, the parties are free to coexist in most of the United States without a likelihood of confusion based on factors other than geography. However, to the extent that D'Amico is conceding that its registrations should be geographically restricted in view of the Coexistence Agreement, Takayama does not object.[1]

III. The Incontestability Status of D'Amico's U.S. Registration No. 3,380,250

In support of its motion, D'Amico points out the incontestability status of one of its prior registrations, relying on the evidentiary benefits provided under 15 U.S.C. §1115. D'Amico also relies heavily on the recent Board decision in *Boi Na Braza, LLC v. Terra Sul Corp.* ___ U.S.P.Q. 2d ___ (TTAB 2014), citing the general rule that where a junior party owns an incontestable registration, the prior user is restricted to "the specific area in which it has

[1] Pursuant to the Coexistence Agreement, Takayama has agreed not to challenge the applications upon which D'Amico's registrations are based. However, to the extent the Board concludes that D'Amico's registrations should be restricted, for example, to include the specific geographic restrictions admitted by D'Amico in its Cross-Motion, or to identify more specifically that the services associated with D'Amico's registrations are "contemporary Mexican restaurant services" as stated in the Coexistence Agreement, the Board has the inherent power to amend D'Amico's registrations pursuant to 15 U.S.C. §1068.

established its prior rights." However, while D'Amico correctly recites the general rule as applied in the *Boi Na Braza* decision, an important exception to the general rule is where the parties have entered an agreement setting forth their respective rights. *See* TBMP §1105, citing *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 U.S.P.Q 330, 334 (TTAB 1980). The *Thriftimart* case also involved a prior user who was seeking a concurrent use registration where the excepted user owned an incontestable registration. *See Thriftimart*, 207 U.S.P.Q at 331-32. However, unlike the facts in the *Boi Na Braza* case, in *Thriftimart* the parties had entered a statement of stipulated facts as to their respective rights. *Id.* at 332-33. There, the Board held that while the general rule would result in limiting the prior user to a territory of actual or constructive use, "in view of the spirit set forth in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973), which encourages the acceptance of agreements between parties designed to avoid a conflict between them," the territorial restrictions to which the parties agreed would override the general rule. *Id.* at 334. Here, similar to the situation in the *Thriftimart* case, the parties have agreed to terms and conditions on their use of their respective marks, clearly fitting within the exception to the general rule. D'Amico's motion should be denied.

IV. D'Amico's Statement of Facts

In support of its Cross-Motion, D'Amico also sets forth twelve bullet points as "Undisputed Facts." Noticeably absent from D'Amico's statement of facts is any reference to the terms of the Coexistence Agreement. Those terms are perhaps the most relevant facts to this dispute. *See Du Pont*, 476 F.2d 1357, 1363, 177 U.S.P.Q. 563, 568 (in assessing the weight to be afforded an agreement between the parties, the court stated that "when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted.") Turning to the "facts" recited by D'Amico, the first nine address D'Amico's registrations, and its purported rights in the MASA mark. However, as explained above, for this concurrent use action, D'Amico's registrations are not in dispute and are of little relevance to the issue before the Board. The tenth point states the circumstances by which this concurrent use action was initiated and similarly is of little

relevance. The eleventh point states that as of February 12, 2008, Takayama had used the MASA mark in connection with a single location in New York City. For purposes of opposing D'Amico's Cross-Motion, Takayama does not dispute the first eleven bullet points. However, in the twelfth bullet point, D'Amico states: "Since 2004, Plaintiff's MASA has been a single location at 10 Columbus Circle, Time Warner Center, 4/F, New York, NY 10019." While Takayama admits that he continues to operate the New York City location of his MASA restaurant, that is not the only location where Takayama provides restaurant services under the MASA trademark. Rather, Takayama has expanded his use of the MASA trademark, to include a restaurant in Las Vegas operating under the "bar MASA" variation of the MASA trademark. *See* the Declaration of Bradley Walz submitted in opposition to Takayama's motion for summary judgment, Docket Entry No. 9, Exhibits 12 and 13, articles discussing Takayama's expansion of the MASA trademark in opening the "Bar MASA" restaurant in Las Vegas. Therefore, Takayama not only disputes the twelfth statement of fact, but submits that evidence introduced by D'Amico proves the statement false.

V. Conclusion

To the extent D'Amico's motion seeks summary adjudication that the geographic scope of protection being sought by Takayama in his concurrent use application should be restricted further than the limitations presently stated, such a motion should be denied as inconsistent with the unambiguous terms of the Coexistence Agreement between the parties.

To the extent D'Amico seeks confirmation that its prior registrations for the MASA mark extend throughout the United States with the exceptions of the state of New York, and fifty miles around New York City, so long as such rights are recognized as being subject to Takayama's concurrent rights as set forth in Takayama's concurrent use application, Takayama does not oppose. Neither would Takayama oppose the amendment of D'Amico's registrations to include specific geographic restrictions pursuant to the Board's inherent power under 15 U.S.C. §1068,

nor the entry of any other restrictions to D'Amico's registrations that would make the scope of those registrations better comply with the terms of the Coexistence Agreement.

Respectfully submitted,

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Dated: May 21, 2014

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CERTIFICATE OF SERVICE

I certify that on May 21, 2014, a true and correct copy of the foregoing A**PPLICANT'S OPPOSITION TO REGISTRANT'S CROSS MOTION FOR SUMMARY JUDGMENT** is being served by electronic mail, to:

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